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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,775	06/29/2001	Will H. Gardenswartz	OBS5GARD-USC2	5962

31518 7590 11/28/2006

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ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/28/2006

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09893775

Filing Date: 29 June 2001

Appellant(s): Gardenswartz et al.

Richard A. Neifeld, Esq., For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7 September 2006 appealing from the Office action mailed 27 February 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Biorge et al., US005806045A, 8 September 1998.

Stein et al., US005459306A, 17 October 1995.

Herz et al., US005754938A, 19 May 1998.

Merriam-Webster's Collegiate Dictionary, 10th ed., 1997.

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Official notice was taken that limitations of claims 57, 58, 60, 61, 71 and 75-85 were well known to those of skill in the art at the time of the instant invention.

DeLapa et al., US006076068A, 13 June 2000.

Merriman et al., US005948061A, 7 September 1999

Shilcrat, US005963948A, 5 October 1999.

Ogasawara, US006123259A, 26 September 2000.

Suzuki, US006129274A, 10 October 2000.

Beaumont et al., US006055513A, 16 February 1999.

Katz et al., US006055513A, 25 April 2000.

Eikeland, US005828837A, 27 October 1998.

Hirono, US006882348B2, 19 April 2005.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the non-final rejection mailed on 27 February 2006.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 18 November 2005 have been fully considered but they are largely moot in view of the following new basis of rejection for all claims except claim 1. The pertinent arguments are addressed at para. 8-10, 15-17 and 21 below. This Office action has been made non-final because the previous rejection of claim 70 was found to be deficient (by relying on a provisional application that had not been sent to applicant, and which in any event did not contain the claimed limitation).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 USC 103(a) as obvious over Biorge et al. in view of Stein et al. (US pat. 5,459,306) and Herz et al.
4. Biorge et al. teaches a method for delivering *incentive credits*, which reads on targeted advertising, comprising: receiving from a first computer (*the portable device*) a first identifier (*encrypted signals*) identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/ targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.
5. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer. A "purchase" is an exchange for money or its equivalent (Merriam-Webster's Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase.
6. Biorge et al. does not teach that that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (*user code*, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer (col. 2 line 66 to col. 3 line 8). Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al.
7. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is

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need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.

8. Applicant argues (p. 14-15) that Biorge et al. does not teach determining a targeted ad based on the consumer's offline purchase history. The *incentive credit* (col. 1 lines 38-49 and col. 5 line 27) is the ad because it advertises the *participating provider* (col. 1 lines 48-49). It is targeted at the specific customer (col. 2 line 21). It is based on the user's purchase history (previous *purchase transactions*, col. 1 lines 38-44). At least some of said previous transactions are offline because the reference teaches *most transactions may be conducted off-line* (col. 2 lines 35-36).
9. Applicant argues (p. 16-18) that there is no motivation to combine Stein et al. with Biorge et al. because the classification information is irrelevant to the purpose of Biorge et al. The justification for combining the references is the statistical efficiency of classification (para. 6 above). Applicant argues that Biorge et al. deals only with "credit information" (e.g., at p. 17 lines 2-3 from the bottom, and col. 18 line 2). Actually, Biorge et al. deals with *incentive credits*, which is to say promotional discounts (col. 5 lines 27-29). Classification would be helpful if, for example, the sponsor was interested in providing said credits to all consumers shopping in a particular pharmacy chain, or in a particular geographical region.
10. Applicant argues (p. 18-19) that there is no motivation to combine Herz et al. with Biorge et al. because Biorge et al. does not disclose or suggest categorizing a consumer based on product selections. While true, that is irrelevant. The justification for combining the references is maintaining confidentiality of the purchase history data (para. 7 above), said data being collected in Biorge et al. (col. 6 lines 38-44). The data are available for abuse, for example revealing to sponsor Walgreen that the customer routinely shops at competitor CVS. Herz et al. teaches making the targeted ad/credits selection so as to prevent this abusive disclosure of customer data.
11. Claims 55, 57-69 and 71-87 are rejected under 35 USC 103(a) as obvious over Stein et al. (US pat. 5,459,306) in view of Merriman et al. (US005948061A).
12. Stein et al. teaches (independent claims 55, 86 and 87) a computer network implemented method and system for delivering targeted advertisements, the method

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comprising: collecting a first consumer/customer/user offline purchase history and identification (col. 2 lines 42-43 and 65-66); storing said consumer/customer/user information (col. 4 lines 14-19); (inherently) receiving from *kiosk 5* its network address, which reads on a "consumer computer first identifier", sending said kiosk network address with the *user code*/first consumer identification to the *coupon controller 9*, which reads on associating said first identifier/kiosk network address with said first consumer identification/*user code*, and determining a targeted advertisement (*targeted promotions*, col. 1 lines 10-12 and *announcements*, col. 4 lines 60-61) for said first consumer based at least in part on said offline purchase history associated with said first consumer identification/*user code* with said first identifier/*kiosk 5* its network address (col. 6 lines 28-51); and delivering said determined targeted advertisement to said first consumer (col. 6 lines 55-57).

13. Stein et al. does not teach that said consumer computer is at the consumer's home or office. Merriman et al. teaches a PDA 16 (col. 3 lines 23-27), which reads on a consumer computer at the consumer's home or office. Because Stein et al. teaches that it is important to keep consumers/users from monopolizing a kiosk 5 consumer computer (col. 6 line 59), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Merriman et al. to those of Stein et al. Stein et al. teaches a local area network (Ethernet, col. 6 line 40) joining the kiosk 5 consumer computers in each store (col. 5 lines 9-12) with ad/coupon controller 9 (col. 6 lines 37-45). Merriman et al. teaches a broader Internet (col. 1 line 30) connecting any number of consumer computers *PDA 16* to *ad server 19*. Because it would enhance consumer convenience and minimize the number of special and *kiosk 5* consumer computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to replace at least some of the *kiosk 5* consumer computers with the *PDA 16* consumer computers accessing coupons/ads over the Internet.
14. Stein et al. also teaches at the citations given above claims 59 (inherently), 64 (where *coupon controller 9* reads on an advertiser's server) and 65-67.
15. Applicant argues (pp. 21 last line) that claims 64 is not taught by Stein et al, because the reference does not teach an advertiser's server as defined in the specification and that claim 65 is not taught (p. 22 first full para.).

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16. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
17. The instant application contains no such clear definition for any terms, including "advertiser's server". In the instant case, the examiner is required to give this term its broadest reasonable interpretation, which is any server of ads. *Coupon controller 9* taught by Stein et al. (col. 6 lines 37-54) reads on that. For claim 65, by the same logic, any mechanism that associates identifiers with corresponding consumer identifications is an association table.
18. Stein et al. also teaches claim 62 (col. 5 line 59), 68 and 72 (where *host system 13*, jointly with *coupon controller 9*, reads on said analytical computer because it provides *rules for predicting purchases*, col. 4 line 13 and col. 5 lines 9-12), 69 (col. 4 line 14).¹
19. Merriman et al. also teaches claims 63 (col. 3 lines 41-47 and col. 4 lines 1-2), and 73 and 74 (col. 7 lines 15-31, where the user response to an ad reads on registration).
20. Neither Stein et al. nor Merriman et al. teaches the purchase history data limitations of claims 57, 58, 60 and 61, IVR (claim 71) or sending a registration web page (claims 75-85). Official notice was taken (para. 15 of the Office action mailed on 6 June 2005) that all of the purchase history data limitations were commonly acquired and are of clear use to a retailer for product promotion, and also that IVR communication and web page registration were common at the time of the invention.
21. Traverse of the taking of Official Notice - On pp. 23-24, applicant has traversed the examiner's taking of official notice (para. 20 above). However, applicant has not

¹ In the original, this sentence was inadvertently ended with a comma.

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provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03).

Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

22. Claim 70 is rejected under 35 USC 103(a) as obvious over Stein et al. (US pat. 5,459,306) in view of Merriman et al. (US005948061A), and further in view of De Lapa et al. (US006076068A). Neither Stein et al. nor Merriman et al. teaches transmitting offline purchase history data in real time. De Lapa et al. teaches transmitting offline purchase history data in real time (*dynamically updated*, col. 9 lines 39-45). Because De Lapa et al. teaches that dynamic/real time updating enables greater profits (col. 3 lines 18-22), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of De Lapa et al. to those of Stein et al. and Merriman et al.

(10) Response to Argument

Argument for independent claim 1 rejected under 35 USC 103(a) as obvious over Biorge et al. in view of Stein et al. and Herz et al.

The rejection relies on three US patent references. Appellant presents three arguments, respectively challenging the merits of each of the references (pp. 4-14 inclusive).

First, appellant argues that Biorge et al. does not teach the following limitation:

“wherein said offline purchase was not transacted with the first computer.” (Claim 1, last line.)

Of critical importance is this sentence in the rejection:

“A ‘purchase’ is an exchange for money or its equivalent (Merriam-Webster’s Collegiate Dictionary).” (Para. 5 of the rejection mailed on 27 February 2006.)

Appellant argues,

“In response, the applicant asserts that Biorge does in fact disclose that device 74 is used for all transactions, because device 74 is involved in every transaction to check for both (1) a previous incentive credit and (2) an incentive credit generated by the present transaction. Therefore, every offline purchase is transacted with customer device 74,

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regardless of whether or not there is a previous incentive credit stored in device 74.

(Brief p. 7, middle para. Emphasis has been modified.)

Appellant's premise is correct - device 74 is "used for" or "is involved in" every transaction – but appellant's conclusion does not follow. As noted above, a "purchase" is an exchange for money, as is a "purchase transaction". Device 74 is not used to perform every exchange for money. Device 74 is indeed used for part of every transaction, but it is not used to complete every transaction to the point that money is exchanged. Being "used for" part of a transaction, or being "involved in" a transaction, does not read on the claimed "transacting a purchase". The purchase is transacted only when money is exchanged, at the end of the process. As explained in the rejection statement,

"The first computer [device 74] is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase." (Rejection para. 5., emphasis added.)

Second, appellant argues (pp. 10 and 11) that there is no motivation to add the teachings of Stein et al. to those of Biorge et al. The pertinent part of the rejection is as follows.

"6. Biorge et al. does not teach that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (*user code*, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer (col. 2 line 66 to col. 3 line 8). Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al." (Rejection para. 6.)

Specifically, appellant argues, "However, the purpose of Biorge is unrelated to classification; it relates only to credit information." (P. 11, 2nd para. from the bottom.) Appellant raised essentially the same argument during prosecution. The examiner replied as follows.

"9. Applicant argues (p. 16-18) that there is no motivation to combine Stein et al. with Biorge et al. because the classification information is irrelevant to the purpose of

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Biorge et al. The justification for combining the references is the statistical efficiency of classification (para. 6 above). Applicant argues that Biorge et al. deals only with "credit information" (e.g., at p. 17 lines 2-3 from the bottom, and col. 18 line 2). Actually, Biorge et al. deals with *incentive credits*, which is to say promotional discounts (col. 5 lines 27-29). Classification would be helpful if, for example, the sponsor was interested in providing said credits to all consumers shopping in a particular pharmacy chain, or in a particular geographical region." (Rejection para. 9.)

There is an even simpler example, perhaps the most common classification, frequent purchaser of some specific good. Say that it is observed that a customer frequently buys baby food. The efficiency of classifying that customer as a frequent purchaser of baby-related goods is obvious.

The examiner has since discovered that the subject limitation is in fact taught by Biorge et al., at col. 5 line 50 to col. 6 line 11, where the "purchase behavior classification" is *the Silver Plan* (col. 5 lines 65-66). The examiner chooses not to change the basis of rejection, but does note that this teaching in Biorge et al. is evidence that the two references have the same purpose.

Third, appellant argues (pp. 12-14) that there is no motivation for adding the third reference, Herz et al., to teach that the targeted ad is selected and delivered without providing the purchase history to an advertiser. The rejection gives customer confidentiality as the motivation:

"7. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history." (Rejection para. 7.)

Appellant argues further (top of p. 13) that Biorge et al. teaches away from the added limitation. However, appellant is only demonstrating that Biorge et al. does not teach the limitation, a fact that was admitted by the rejection. Herz et al. teaches that the user (customer) "may desire" to keep their purchase history confidential, because, among other

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reasons given, "confidentiality with respect to purchasing behavior is the user's legal right in many states." Hence appellant's argument implies that Biorge et al. teaches away from obeying the law. There is no support for this extreme argument.

Appellant admits (p. 13, 4th line from the bottom), "Herz is directed to delivering product offers to a customer", but then goes on to argue, "The purposes for Biorge's and Herz's process are unrelated." But, as was noted above, delivering product offers to a customer is essentially the purpose of Biorge et al. and of Herz et al.

Argument for claims 55, 59, 62-69, 72-74, 86 and 87 rejected under 35 USC 103(a) as obvious over Stein et al. in view of Merriman et al.

Appellant specifically traverses (pp. 14-18 of the brief) the following statement adding Merriman et al. to Stein et al. in order to reject independent claims 55, 86 and 87.

"13. Stein et al. does not teach that said consumer computer is at the consumer's home or office. Merriman et al. teaches a PDA 16 (col. 3 lines 23-27), which reads on a consumer computer at the consumer's home or office. Because Stein et al. teaches that it is important to keep consumers/users from monopolizing a kiosk 5 consumer computer (col. 6 line 59), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Merriman et al. to those of Stein et al. Stein et al. teaches a local area network (Ethernet, col. 6 line 40) joining the kiosk 5 consumer computers in each store (col. 5 lines 9-12) with ad/coupon controller 9 (col. 6 lines 37-45). Merriman et al. teaches a broader Internet (col. 1 line 30) connecting any number of consumer computers PDA 16 to ad server 19. Because it would enhance consumer convenience and minimize the number of special and kiosk 5 consumer computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to replace at least some of the kiosk 5 consumer computers with the PDA 16 consumer computers accessing coupons/ads over the Internet." (Rejection para. 13.)

It has been noted to the examiner that this rejection is unnecessary because Stein et al. teaches the subject limitation inherently. When an employee of the store makes personal use of a kiosk in the store, the kiosk reads on "a computer at said first consumer's office".

However, the examiner chooses not to change the basis of rejection, so appellant's traverse will be addressed.

Note first that the only limitation not taught by the primary reference, Stein et al., is the use of a consumer computer at the consumer's home or office. As noted in the paragraph quoted above, Stein et al. teaches only kiosk consumer computers in each store connected to an ad server by a LAN. Merriman et al. teaches PDA consumer computers operating on the Internet.

The rejection gives two reasons why it would it would have been obvious to replace the LAN and at least some of the *kiosk 5* consumer computers with the *PDA 16* consumer computers accessing coupons/ads over the Internet:

- (1) Because Stein et al. teaches that it is important to keep consumers/users from monopolizing a *kiosk 5* consumer computer; and
- (2) Because it would enhance consumer convenience.

Appellant argues (pp. 15-16) that the first reason is deficient. However, when it is viewed as a symptom of a problem to be solved, it makes sense. Stein et al. is concerned with lack of access to product-selling ads because its terminals are limited to in-store kiosks. It is a legitimate concern since the number of kiosks could never be great. Merriman et al. offers the obvious solution: replace the LAN with the Internet and allow customers to access the ads with their own PDAs, from anywhere where they can get 'net access. This eliminates the bottleneck at the kiosks, and will in fact enhance customer convenience.

Appellant also argues (p. 16-17) that the Stein and Merriman networks "are not interchangeable", by which appellant means that the two references do not teach all the same features. That is irrelevant. The rejection is proposing to replace the Stein LAN with the Merriman Internet, and allowing the use of personal PDAs as well as some in-store kiosks. The rejection is proposing a straightforward replacement without technical difficulties. Appellant goes on to argue (p. 16 bottom) that Stein delivers its projections in real time. Again, this is not a limitation of the claim and has no bearing on the rejection. The rejection is proposing a straightforward replacement of a LAN with the Internet. It would work in real or delayed time.

Appellant also argues (p. 18-20) that the rejection of claims 64-67 is improper because Stein et al. does not teach an advertiser's server "as defined/disclosed in the specification". Appellant raised this argument during prosecution and it is addressed at para. 15-17 of the rejection reproduced above. In essence, "Unless a term is given a 'clear definition' in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111)." The rejection notes that "advertiser's server" is not clearly defined in the specification, and accordingly goes on to reject the claims based on the broadest reasonable interpretation of the term.

Now, appellant argues (p. 19, middle) that the following part of the specification "... defines an advertiser's server as a device that sends a cookie to a client computer system."

"Currently, advertisers are able to implement a limited form of targeted advertising over the Internet. This is accomplished by sending a block of data, such as a "cookie," from a remote host or server (i.e., a Web server) maintained by an advertiser to a computer (i.e., a - client system) that has access to the remote server via the World Wide Web. A cookie, as used in network and Internet communication, is a block of data or state object that a Web server stores on a client system. When the client system accesses a Web site within a limited range of domain names, the client system automatically transmits a copy of the cookie to the Web server that serves the Web site. The cookie may include a unique cookie number corresponding to the client system. Thus, the cookie can be used to identify the client system (by identifying the Web browser) and to instruct the server to send a customized copy of the requested Web page to the Web browser." (Spec. p. 2 line 23 to p. 3 line 3.)

There is nothing here that even remotely approaches a special, clear definition of "advertiser's server". If appellant wanted the claim limited to a server sending a cookie, appellant should have claimed this limitation. Without such a clear definition, the law does not permit the examiner to read this limitation into the claims from the spec.

Appellant also argues (p. 20 top) that there is no showing of the "association table" limitation of claim 65. Appellant raised this argument during prosecution and it was addressed in the rejection reproduced above. First, the rejection explains that "associating" is taught:

“... sending said kiosk network address with the *user code*/first consumer identification to the *coupon controller 9*, which reads on associating said first identifier/kiosk network address with said first consumer identification/*user code*,” (rejection para. 12, emphasis added)

Second, by the logic discussed above:

“The instant application contains no such clear definition for any terms, including “advertiser’s server”. In the instant case, the examiner is required to give this term its broadest reasonable interpretation, which is any server of ads. *Coupon controller 9* taught by Stein et al. (col. 6 lines 37-54) reads on that. For claim 65, by the same logic, any mechanism that associates identifiers with corresponding consumer identifications is an association table.” (Rejection para. 17, emphasis added.)

Appellant also argues (pp. 22-23 top) that the rejection of claims 73 and 74 are improper because Merriman’s user response to an ad does not read on registration. Again, appellant is arguing that some special, narrow meaning should be read into the claims. Appellant has not “clearly defined” any special meaning for “registration”, so the examiner is obligated to give the term it’s broadest reasonable interpretation, which the examiner judged to be voluntarily providing user information. Appellant argues (p. 23, top) that this is tantamount to “eavesdropping”, but Merriman et al. teaches (col. 7 lines 20-21) that the information, while provided automatically, can come from a log in ID, which must be provided voluntarily. Hence Merriman’s user response to an ad does read on registration.

Argument for claims 57, 58, 60, 61, 71 and 73-85 rejected under 35 USC 103(a) as obvious over Stein et al. in view of Merriman et al. and the examiner’s official notice

Appellant first argues (top of p. 25) that the rejection does not meet the general criteria for a rejection under 35 USC 103(a). The only issue specifically raised by appellant is the propriety of adding the teachings of Merriman et al. to those of Stein et al., and that has been addressed above.

Appellant also argues (pp. 24 bottom and pp. 25-26) that the examiner has not met his burden regarding the taking of official notice. Said official notice was first taken in the Office action mailed on 15 June 2005 and first traversed in appellant’s reply filed on 18 November

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2005. It is helpful to review this history before considering appellant's present argument.

The examiner wrote:

"15. Claim 57-61, 71 and 73-85 are rejected under 35 USC 103(a) as obvious over Stein et al. Stein et al. does not teach the purchase history data limitations of claims 57-61, IVR (claim 71) or registration at a web page (claims 73-85). Official notice is taken (MPEP § 2144.03) that all of the purchase history data was commonly acquired and are of clear use to a retailer for product promotion, and also that IVR communication and web page registration were common at the time of the invention. It is obvious to follow common practices." (Para. 15 of the Office action mailed on 6 June 2005.)

Appellant replied:

"As per claims 57-61, the examiner takes official notice that it is allegedly old and well known for offers to teach the purchase history limitations of claims 57-61. However, the examiner's official notice does not address the purchase history limitations of claims 57-61. Specifically, claims 57-61 define attributes of said first consumer offline purchase history. Neither Stein nor the examiner's official notice suggest modifying Stein to include the limitations of "said first consumer offline purchase history," as defined by claims 57-61. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejections of claims 57-61 are improper and should be withdrawn.

As per claim 71, the examiner takes official notice that it is allegedly old and well known for offers to teach the purchase history limitations of claim 71. However, the examiner's official notice does not address the limitations of claim 71. Specifically, claim 71 defines exchanging information between [an] IVR provider and said analytical computer system; providing an IVR message to said first consumer from said IVR provider. Neither Stein nor the examiner's official notice suggest modifying Stein to include "exchanging information between [an] IVR provider and said analytical computer system; providing an IVR message to said first consumer from said IVR provider," as defined by claim 71. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 71 is improper and should be withdrawn.

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As per claims 75-83, the examiner takes official notice that it is allegedly old and well known for offers to teach the limitations related to claims 75-83 regarding registration at a web page.

However, the examiner's official notice does not address the limitations of claims 75-83. Neither Stein nor the examiner's official notice suggest modifying Stein to include the limitations related to claims 75-83 regarding registration at a web page. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejections of claims 75-83 are improper and should be withdrawn." (Reply filed 18 November 2005, bottom para. on p. 23 and the first four para. on p. 24.)

An examiner takes official notice to avoid the cost of producing evidence in those cases where "the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." (MPEP Rev. 3, August 2005, § 2144.03.A, emphasis added.)

However,

"If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See Soli, 317 F.2d at 946, 37 USPQ at 801; Chevenard, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP Rev. 3, August 2005, end of § 2144.03.B, emphasis added.)

Finally, "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." (MPEP Rev. 3, August 2005, beginning of § 2144.03.C, emphasis added.)

The examiner will shortly show that the facts asserted to be common knowledge were indeed well known. However, the one sentence explanation given to the appellant in the 6 June 2006 is hardly expansive. Whether or not it met the requirement to "provide specific

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factual findings” is for the Board to decide. In doing so the Board should consider that the appellant and its learned advocate are well skilled in the present art.

The appellant has not stated “why the noticed fact is not considered to be common knowledge or well-known in the art”, as the MPEP counsels. Appellant may argue that this is because the examiner did not provide the required “specific factual findings” for rebuttal. The examiner suggests this alternative: appellant did not attempt an effective traverse because none is possible in view of the following facts.

Claims 57, 58, 60 and 61: The following references each teach consumer purchase history data including the SKU (stock keeping unit, the lowest level product ID), UPC (universal product code, the bar code ID of a product), price and date of an item purchased: Shilcrat, Ogasawara and Suzuki. All obviously enhance the usefulness of purchase history data for ad targeting and sales promotion.

Claim 71: The following references each teach IVR (interactive voice response) for ad targeting using consumer purchase history: Beaumont et al and Katz et al. Both teach that IVR is intended to provide precisely the added limitations of claim 71.

Claims 75-85 The following references each teach sending a registration web/home page for ad targeting: Eikeland and Hirono.

Argument for claim 70 rejected under 35 USC 103(a) as obvious over Stein et al. in view of Merriman et al. and further in view of DeLapa

The rejection is

“22. Claim 70 is rejected under 35 USC 103(a) as obvious over Stein et al. (US pat. 5,459,306) in view of Merriman et al. (US005948061A), and further in view of De Lapa et al. US006076068A). Neither Stein et al. nor Merriman et al. teaches transmitting offline purchase history data in real time. De Lapa et al. teaches transmitting offline purchase history data in real time (*dynamically updated*, col. 9 lines 39-45). Because De Lapa et al. teaches that dynamic/real time updating enables greater profits (col. 3 lines 18-22), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of De Lapa et al. to those of Stein et al. and Merriman et al.” (Para. 22 of the rejection reproduced above.)

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To traverse, appellant present the following argument:

"In response, the applicant asserts that Stein's offsite host system 13 discloses dialing up the point-of-sale computer 11 once per day. Dial up is not compatible with real-time updating. Claim 70 recites "transmitting said first consumer offline purchase history data for said offline purchase transaction from a retail store where said offline purchase transaction occurs to [said analytical computer system not located in said retail store] in real time." For this additional reason, the rejection of claim 70 is improper and should be reversed." (Last para. on p. 26 of the brief.)

Appellant's point is technically correct, but it is a weak straw man. First, appellant's argument ignores the second reference, Merriman et al. As noted above, the addition of Merriman's teachings would replace the Stein's LAN with the Internet. For the customer convenience reason discussed there, as well as for the technical reason given by the appellant, one of ordinary skill in the art would know to replace Stein's dial up connection with a connection supporting real time transmission.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Conferees:

Jeffrey D. Carlson 

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20 November 2006